

REMARKS

Upon approval of the undersigned's request for entry of the present amendment, claims 83-92 will be pending. As directed by the Examiner in the previous Office Action, the undersigned is affirming the election to prosecute the invention of Figs. 14 and 15, in species and genus form. The undersigned respectfully asserts that currently pending claims 83-92 are fully supported by the invention shown in Figs. 14 and 15, but consider that other species disclosed in the specification may also be addressed by these claims.

The Examiner has also requested identification of related patent applications to aid in review of potential double patent rejections. US Patents 5,381,685 and 6,000,251 are priority applications to the present application. In the application that matured into the '251 application, a multiple restriction/election requirement was entered. Species A, corresponding in part to an originally filed patent application, and Species B (corresponding to Figs. 14 and 15) were identified. Species A has been prosecuted as US Patents 5,493,878 and 6,112,562. Species B has been prosecuted as US patents 5,502,989 and 6,155,088. Other applications are pending to other species identified in related applications having specific election/restriction requirements other than Species A or Species B.

The Office communication of December 31, 2001 asserts that the response filed October 15, 2001 was not fully responsive for failing to particularly set forth the patentable novelty of the claims with respect to the prior art.

The previous Office Action rejected the pending claims under 35 U.S.C. 102(b) in light of two independent references: Rimanek and Sloop, Sr. The undersigned thanks the Examiner for the opportunity to supplement the comments of the October 15, 2001 amendment.

Independent claims 83 and 88 both recite a locking system that includes a portable electronic device. The Rimanek reference fails to teach or suggest this element. The fact that portable electronic devices typically include relatively thin walls surrounding delicate electronic components makes the Rimanek solution inapplicable. The first reason is

the art is non-analogous and a person of ordinary skill in the art in considering the problem of securing a portable electronic device would not be motivated to use technology for securing sail boards and the like. Second, assuming *arguendo* that the art is analogous, a person of ordinary skill in the art would not be motivated to modify the Rimanek teaching. Because element 4 would have to extend deep into the device to inhibit being rocked out, modifying the Rimanek solution is not workable. Because element 4 extends too shallow to maintain any secure attachment, Rimanek would not be used for a shallow wall, as is found in a portable electronic device. The rejection of claim 83 is respectfully requested to be withdrawn. The patentability of claim 88 is respectfully asserted.

Independent claim 88 is also patentable for at least an additional reason. Namely it recites a locking member that is fixed relative to the housing. In Rimanek, the identified locking member element moves relative to the identified housing element. Therefore, the patentability of claim 88 is respectfully asserted again.

Claims 84–87 and claims 89–92, directly or indirectly dependent from claim 83 and claim 88 respectively, are all patentable for at least the reasons set forth above in the discussion of the patentability of the respective claim. In addition, claims 87 and 92 are patentable in their own right as they recite a pin extending through the housing. The rejection identifies the pin element as an extension of the housing element, hence it does not extend through as recited. Thus the rejection of claim 87 is requested to be withdrawn, and the patentability of claim 92 is asserted.

Regarding claims 83 and 88, as discussed above the claims recite a portable electronic device. Sloop, Sr., teaches a barrel lock assembly for securing a lock housing over a latch or access point of a securable enclosure. The reference fails to teach a portable electronic device. Sloop, Sr. secures a lockable enclosure that may contain a utility meter box. However, any part of the disclosed Sloop, Sr. system that could be considered portable is not electronic. Additionally, the Sloop, Sr. reference is not analogous as the Sloop, Sr. solution is directed to access control while the present invention relates to a physical security device that inhibits unauthorized movement (e.g., theft) of the portable electronic device.

Thus, the rejection of claim 83 is respectfully requested to be withdrawn, and the patentability of claim 88 is asserted.

Independent claim 88 is also patentable for at least two additional reasons. First, claim 88 recites a locking member that is fixed relative to the housing. In Sloop, Sr., the identified locking member element moves relative to the identified housing element. Second, the claim recites that the cable inhibits movement of the electronic device beyond a predetermined distance from the object. The Sloop, Sr. reference does not satisfy or suggest this element. Specifically, Sloop, Sr. has no element that could be called 'electronic' that would move relative to the object, whenever the cable inhibits the movement thereof. The disclosed meter is anchored to an attachment point, a box surrounds the meter, a lock keeps the box shut and the padlock keeps the lock in place. Therefore, the patentability of claim 88 is respectfully asserted again.

Claims 84–87 and claims 89–92, directly or indirectly dependent from claim 83 and claim 88 respectively, are all patentable for at least the reasons set forth above in the discussion of the patentability of the respective claim. In addition, claims 87 and 92 are patentable in their own right as they recite a pin extending through the housing. The rejection identifies a pin element as a structure extending into but not through the housing, hence it does not extend through as recited. Thus the rejection of claim 87 is requested to be withdrawn, and the patentability of claim 92 is asserted.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned “Version with markings to show changes made.”

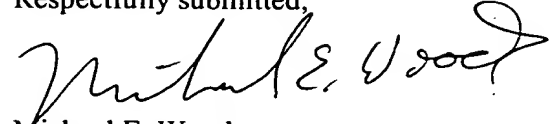
CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-393-2000.

The Assistant Commissioner of Patents is hereby authorized to charge any
fees due to Deposit Account 50-1193.

Respectfully submitted,



Michael E. Woods
Reg. No. 33,466

McCutchen, Doyle, Brown & Enersen
Three Embarcadero Center, Suite 1800
San Francisco, California 94111-4067
Tel: (415) 393-2128
Fax: (415) 393-2286

Dated: January 31, 2002

21403293

"VERSION WITH MARKINGS TO SHOW CHANGES MADE"

In the claims:

Claims 88–92 have been added as set forth below.

1 88. (NEW) A locking system, comprising:
2 a portable electronic device having a wall defining a security slot;
3 a housing including a slot engagement member having a slot engaging
4 portion provided with a locking member sized to enter into and be removed from said security
5 slot when in an unlocked position, said slot engagement member being moveable between said
6 unlocked position and a locked position wherein said locking member is retained within said
7 security slot and wherein said pin is fixed relative to said housing;
8 a pin, coupled to said housing and within said security slot when said
9 slot engagement member is in said locked position, for inhibiting movement of said slot
10 engagement member from said locked position; and
11 a cable, coupled to said housing, for attaching to an object other than
12 said portable electronic device to inhibit movement of said portable electronic device beyond a
13 predetermined distance from said object.

1 89. (NEW) The locking system of claim 88 wherein said slot engagement
2 member rotates when moving between said unlocked position and said locked position.

1 90. (NEW) The locking system of claim 88 wherein said slot engaging
2 portion is complementary to preselected dimensions of said security slot.

1 91. (NEW) The locking system of claim 88 wherein said pin extends into
2 said security slot when said slot engagement member is in said locked position.

1 92. (NEW) The locking system of claim 91 wherein said pin extends
2 through said housing.